

Page 15  
Serial No. 10/768,340  
Response to Official Action

**In the Drawings**

There are no amendments to the drawings.

**Remarks**

Applicant has amended Claims 1, 7-9, 11-14, 19, 23, 25-26, 30, 33, 35 and 37. Applicant has cancelled Claims 6, 10, 20-22, 34 and 36. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. Entry of the amendment and favorable consideration thereof is earnestly requested.

**Claims 1 and 14**

As amended, Claim 1 requires "a locking pin extending through the top plate, the locking pin engaging with one of a plurality of locking holes located in the base plate" and "an alignment device for aligning the locking pin with one of the plurality of locking holes when selecting one of the plurality of rotational positions, said alignment device providing an indication to a user when the locking pin is substantially aligned with one of the plurality of locking holes." As amended, Claim 14 requires "aligning the locking mechanism with one of a plurality of locking holes provided in a base portion of the snowboard binding interface with an alignment device provided in the snowboard binding interface, the alignment device providing an indication to a user when the locking mechanism is substantially aligned with one of the plurality of locking holes."

The Examiner has cited U.S. Patent No. 6,905,133 ("Lett") as disclosing "an alignment device (24) for aligning the locking element with one of the plurality of rota-

tional positions.” (Official Action 4/6/06, p. 2.) Applicant respectfully submits that item (24) of Lett comprises a “slot 24” through which extends “locking lever 32.” (Col. 5, lines 39-45; See, FIGS. 3-6.) While the locking lever 32 is “manufactured from a resilient material such as spring steel or robust plastic” and may selectively be displaced to engage with detents 40 positioned along an edge portion of perimeter wall 20, nowhere does Lett teach, disclose or suggest an alignment device that provides an indication to the user when the locking pin is substantially aligned with one of the plurality of locking holes as required by Claims 1 and 14. Lett has no need of an alignment device according to Claims 1 and 14 because Lett teaches use of only a couple of adjustment positions, which the locking lever may laterally engage with. Alternatively, the alignment device of Claims 1 and 14 gives an indication to the user when the vertically displaceable locking pin is substantially aligned with one of the many locking holes positioned on the top of the base plate.

Applicant further respectfully submits that U.S. Patent No. 5,803,481 (“Eaton et al.”) also fails to teach or suggest an alignment device providing an indication to a user when the locking pin is substantially aligned with one of the plurality of locking holes as required by Claims 1 and 14.

Accordingly, Applicant respectfully submits that because neither Lett nor Eaton et al. teach, disclose or suggest an alignment device providing an indication to a user when the locking pin is substantially aligned with one of the plurality of locking holes as

required by Claims 1 and 14, none of the cited art alone or in combination can anticipate or render Claims 1 and 14 obvious.

It is well settled that the mere fact that references can be combined or modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art “may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so.”). In the present case, Applicant respectfully submits that there is no suggestion in either Lett or Eaton et al. to provide an alignment device providing an indication to a user when the locking pin is substantially aligned with one of the plurality of locking holes nor was such contemplated by either reference. Applicant submits that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification and “[t]hat knowledge can not come from the applicant's invention itself.” *In re Oetiker*, 977 F.2d, 1443, 1447 (Fed. Cir. 1992). See also *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to modify must be found in the prior art, not the applicant's disclosure).

Accordingly, Applicant respectfully submits that because none of the cited prior art suggest further modification according to Claims 1 and 14, it cannot be obvious to further modify the suggested combination to include an indication to a user when the

locking pin is substantially aligned with one of the plurality of locking holes as required by Claims 1 and 14.

Claim 19

Applicant has amended Claim 19 to include the limitations of Claims 20-22, which the Examiner indicated would be allowable over the cited prior art. Accordingly, Applicant respectfully submits that Claim 19 is in condition for allowance.

Claim 28

Claim 28 requires "an outer ring captured by said stationary annular retaining ring, said outer ring having an inner circumference ( $L_4$ ), where ( $L_3$ ) is greater than ( $L_4$ )."

The Examiner has cited Lett as disclosing this limitation, however Applicant has been unable to determine where this limitation has been identified in Lett and Applicant respectfully submits that this limitation is not shown in Lett. (Official Action 4/6/06, p. 2.)

For example, the Examiner has cited the following elements of Lett, "a base plate (18)", "a locking device (32, 44, 48)", "a stationary annular retaining ring (36, 36a)", "a binding plate (30)" and "a top plate (14)", which the Examiner has referenced from FIGS. 3-4 of Lett. However, Applicant notes that the "outer ring" recited in Claim 28 is not taught, disclosed or suggested in either Lett or Eaton et al. The outer ring of Claim 28 may be seen, for example, in FIGS. 8A and 11 of the pending application described as "outer ring 24" where it can be seen that the outer ring is captured by the stationary

annular ring. (See, FIGS. 8A & 11, Par. 57-59 & 61-62.) In addition, there is no equivalent structure in either Lett or Eaton et al., which performs the same function as the outer ring. (See e.g., Par. 64.)

Accordingly, Applicant respectfully submits that because neither Lett nor Eaton et al. teach, disclose or suggest an outer ring captured by said stationary annular retaining ring, said outer ring having an inner circumference ( $L_4$ ), where ( $L_3$ ) is greater than ( $L_4$ ) as required by Claim 28, nor does the cited art have any structure that corresponds or performs the same function of the outer ring, none of the cited art alone or in combination can anticipate or render Claim 28 obvious.

#### Claim 30

As amended, Claim 30 requires "a binding plate captured by said stationary annular retaining ring, said binding plate rotationally displaceable to a plurality of rotational positions with respect to said stationary annular retaining ring, said binding plate having a beveled outer edge having an angle  $\beta$ , where the sum of angle  $\alpha$  and angle  $\beta$  equal  $180^\circ$ ."

The Examiner has submitted that "the lip comprises a chamfered edge having an angle alpha and the binding plate has a chamfered outer edge having an angle beta, where the sum of angle alpha and angle beta equal  $180^\circ$ , see Figure 4." (Official Action 4/6/06, p. 3.) However, as amended, Claim 30 requires "a beveled outer edge", which is defined in The American Heritage Dictionary Of The English Language as "The angle

or inclination of a line or surface that meets another at any angle but  $90^\circ$ ." (American Heritage Dictionary, p. 175.) Applicant respectfully submits that neither Lett nor Eaton et al. teach, disclose or suggest a beveled outer edge as required by Claim 30. Rather Lett teaches that the angle between locking ring 36 and swivel plate 30 is exactly  $90^\circ$ . (See, FIGS. 3 & 4.)

This is not an insignificant difference. The beveled surface provides an angled surface, which allows snow and ice to run off of rather than the horizontal surfaces as taught in Lett. (See e.g., Par. 64.) Accordingly, Applicant respectfully submits that because neither Lett nor Eaton et al. teach, disclose or suggest a binding plate captured by said stationary annular retaining ring, said binding plate rotationally displaceable to a plurality of rotational positions with respect to said stationary annular retaining ring, said binding plate having a beveled outer edge having an angle  $\beta$ , where the sum of angle  $\alpha$  and angle  $\beta$  equal  $180^\circ$  as required by Claim 30, none of the cited art alone or in combination can anticipate or render Claim 28 obvious.

As stated above, it is well settled that the mere fact that references can be combined or modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art "may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so."). In the present case, Applicant re-

spectfully submits that there simply is no suggestion in either Lett or Eaton et al. to provide a binding plate having a beveled outer edge.

Accordingly, Applicant respectfully submits that because none of the cited prior art suggest further modification according to Claim 30, it cannot be obvious to further modify the suggested combination to include a binding plate having a beveled outer edge as required by Claim 30.

#### Claims 33 and 37

As amended, Claim 30 requires “a stationary annular retaining ring coupled to said base plate, said annular retaining ring having an inner circumference ( $L_1$ ), said annular retaining ring having a continuous inner wall” and “a binding plate having a continuous outer wall abutting said continuous inner wall and having a circumference ( $L_2$ ), where ( $L_2$ ) is greater than ( $L_1$ ), and said binding plate is maintained fully within said stationary annular retaining ring with no portion thereof extending beyond an outer perimeter of said stationary annular retaining ring” and “said base plate having a plurality of recesses positioned on an upper surface thereof and selectively engagable with a vertically displaceable locking element to lock said binding plate in one of the plurality of rotational positions, said plurality of recesses substantially evenly spaced around a perimeter of said base plate.” As amended, Claim 37 requires “a first stationary portion coupled to the snowboard comprising a continuous enclosed ring” and “a second moveable portion coupled to the snowboard binding, said second moveable portion being



captured by said first stationary portion such that said second moveable portion is maintained fully within said first stationary portion with no portion thereof extending beyond an outer perimeter of said first stationary portion."

Applicant respectfully submits that Lett teaches a "swivel plate 30 is rotatably mounted within cavity 22 of housing 16" and that a "locking lever 32 projects laterally outward from plate 30, along with a base 18 having "a slot 24 formed in a perimeter wall." (Col 5, lines 39-45; See, FIGS. 3 & 4.) Accordingly, Lett teaches that the base 18, which the Examiner as cited for the base plate, has a slot 24 which extends around an annular circumference of base 18, the locking lever 32 projecting through slot 24. (See, FIGS. 3-6.) Therefore, Lett fails to teach or suggest a continuous wall or a continuous enclosed ring as required by Claims 33 and 37 or that the binding plate (second moveable portion) is maintained fully within the stationary annular ring (first stationary portion) with no portion thereof extending beyond an outer perimeter of said stationary annular ring (first stationary portion) as required by Claims 33 and 37. Eaton et al. also fails to teach or disclose this limitation.

Accordingly, Applicant respectfully submits that because neither Lett nor Eaton et al. teach, disclose or suggest a binding plate maintained fully within said stationary annular retaining ring with no portion thereof extending beyond an outer perimeter of said stationary annular retaining ring as required by Claim 33 or a second moveable portion captured by said first stationary portion such that said second moveable portion is maintained fully within said first stationary portion with no portion thereof extending beyond

an outer perimeter of said first stationary portion as required by Claim 37, none of the cited art alone or in combination can anticipate or render Claims 33 and 37 obvious.

Applicant further respectfully submits that Lett actually teaches away from this limitation. It is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that the locking lever 32 must protrude through the wall as illustrated, otherwise the user could not disengage the system to swivel the device. Alternatively, if no locking mechanism were provided the device would be unusable.

The configuration taught in Lett suffers from a number of drawbacks. For example, the lateral opening (slot 24) is undesirable because it allows snow and ice to enter the interior of the device leading to difficult actuation. Alternatively, the pending claims variously require that the walls are continuous and enclosed. There are no openings provided therein, which prevents the build-up of snow and ice as will happen with the system taught in Lett.

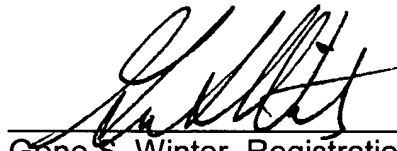
As stated above, it is well settled that the mere fact that references can be combined or modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art "may be

capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so."). In the present case, Applicant respectfully submits that there simply is no suggestion in either Lett or Eaton et al. to modify the combination according to the pending claims, in fact, Lett teaches away from such a modification.

It is respectfully submitted that claims 1-5, 7-9, 12-19, 23-33, 35 and 37-47, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

October 5, 2006



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